

ATTACHMENT A

Remarks

Claims 1-23 are pending in the present application. By this Amendment, Applicant has amended claims 10, 15 and 23. For the reasons set forth below, it is respectfully submitted that the present application is now in condition for allowance.

Claims 1-3, 5-13 and 15-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,631,188 (Sands). This rejection is respectfully traversed, although as indicated above, three of the claims have been amended.

In the Office Action, in rejecting claims 1-2, 10-12 and 15, it was stated that Sands teaches a caller ID unit for identifying caller information associated with an incoming call (citing Sands, Figure 5) and scheduling means for a call-back (citing Sands, Abstract). It was further stated that it was unclear whether the caller ID unit is incorporated into the telephone 12. However, it was contended in the Office Action that it would have been obvious to one of ordinary skill in the art to incorporate the caller ID unit into the phone 12 as such would only entail putting two separate devices used together and incorporating them into one device.

Contrary to the Office Action, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to combine the dynamic call waiting phone system of Sands into a telephone. Sands is directed to a

telephone system comprising a dynamic call waiting system based on caller ID in which calls are routed based on the calling number, and are, for example, routed to voicemail, a forwarding number or scheduled for a call back (Sands, Abstract). Moreover, the disclosed dynamic call waiting system functions to route calls while a user is using a telephone.

Sands fails to provide any enabling disclosure which would allow one of ordinary skill in the art to modify a telephone so that the telephone would function as a telephone for carrying on a telephone conversation as well as, to function to re-route incoming telephone calls in accordance with the disclosed dynamic call waiting system which is incorporated in a telephone network, i.e., dynamic call waiting system 10, remote from a telephone connected to the system. In order for a reference to be anticipatory, the reference must be enabling, i.e., the reference must teach one of ordinary skill in the art how to make or carry out the claimed invention without undue experimentation (see Elan Pharmaceuticals, Inc. v. Mayo Foundation, 64 USPQ2d 1292 (Fed. Cir. 2002)). Since Sands fails to enable one of ordinary skill in the art to produce the present invention as claimed in claim 1 which recites, *inter alia*, scheduling means disposed in a first device which enables one to speak to an initiator of an incoming call, and schedule, by the user, a call back based on an identified caller information, claim 1 is not obvious in view of Sands.

Further, it is respectfully submitted that dependent claims 2-9 and 23 are also not obvious in view of Sands for at least the same reasons given above in

support of the patentability of claim 1, and, further, because these claims recite additional elements not taught or suggested by Sands. For example, with regard to claim 23, which, as now amended, more clearly recites the claimed scheduled call back feature, Sands fails to teach or suggest an apparatus which enables a user of a first device to, at the option of the user and, based on selection by the user after receiving the incoming call, automatically schedule a call-back.

In contrast to the present invention in which, after receiving a telephone call, the user can select to schedule a call back, Sands discloses a call waiting system in which a scheduled call back is stored, i.e., selected, prior to receiving a telephone call. In other words, a user of the Sands system can select to activate a call back feature prior to receiving a telephone call but not after. Further, in Sands, it is the dynamic caller ID system, illustrated, for example by step 160, which determines if a call back service is to be used when the called party is unavailable. If so, the service provider, at step 160, schedules a call back to the called party when the called parties line is no longer busy (Sands, col. 6, lines 46-53 and Figure 6). Therefore, it is the phone system in Sands which does the initiation of automatic call back based on a previous instruction of a user prior to a call being initiated.

Conversely, in the present invention as claimed in claim 23, the user makes the selection to schedule the call back after receiving the phone call, not prior to receiving the phone call. For the foregoing reasons it is respectfully submitted that, Sands does not teach or suggest claim 23.

With regard to claims 10-13 and 15-18, consistent with the amendments made to claim 23, independent claims 10 and 15 have also been amended to more clearly recite that the recipient of an incoming communication optionally selects, after receiving an incoming call, to initiate automatic scheduling of a response. As discussed above with regard to claim 23, Sands fails to teach or suggest an arrangement wherein a recipient, after receiving an incoming communication, selects and initiates automatic scheduling of a response. Instead, Sands merely teaches that a recipient, prior to receiving an incoming call, sets up an automatic call back feature. Nowhere does Sands teach or suggest a user selecting, after receiving an incoming call, initiation of automatic scheduling as claimed. Moreover, it is respectfully submitted that Sands does not teach or suggest that a recipient of a call would or could make any determination with respect to, or provide initiation of, automatic scheduling of a call back by the recipient in response to an incoming call. Sands merely teaches an automated system which may schedule a call back if a recipient, prior to receiving an incoming call, has configured the system accordingly. Based on the foregoing, it is respectfully submitted that claims 10-13 and 15-18 are not obvious in view of Sands.

In summary regarding this group of claims, for the reasons set forth above, it is respectfully requested that the rejections of claims 1-3, 5-13 and 15-18 under 35 U.S.C. § 103(a) be withdrawn.

Claims 4, 14, 19 and 22-23 have been rejected under 35 U.S.C. § 103(a) as being “unpatentable over Sands in view of U.S. Patent No. 6,760,423 (Todd).” This rejection is respectfully traversed.

In the Office Action, it was stated that Sands teaches the claimed device except for a calendar aspect of the invention, and that Todd teaches a calendar situated in a phone (citing Todd, Figure 4a) wherein the calendar initiates the call.

It is respectfully submitted that, contrary to the Office Action, Sands in view of Todd fails to teach or suggest the subject matter of claims 4, 14, 19 and 22-23. As an initial point, it is respectfully submitted that one of ordinary skill in the art would not combine Sands and Todd given the actual teachings of the references. Moreover, there is no teaching or motivation to suggest the combination of these two very different disclosures.

As indicated above, Sands is directed to a dynamic call waiting arrangement based on a caller ID telephone system in which the system, itself, does not constitute a device which allows a user to speak to an initiator of an incoming call. Further, Sands is directed to a dynamic call waiting arrangement designed for redirecting a caller, i.e., the party attempting the call, when the called party is on the phone (i.e., when the line is busy). Accordingly, an individual placing the call must be able to be in contact with the Caller ID system at all times in order to effectuate the basic goal of Sands, i.e., redirecting a call and, optionally, scheduling a call back when the line is no longer busy.

In contrast, Todd is directed to a handheld wireless device which includes a calendar for allowing a user to schedule appointments and for then placing telephone calls based on previously stored appointments.

It is respectfully submitted that there is no teaching or suggestion in Sands or Todd that would lead one of ordinary skill in the art to incorporate a dynamic call waiting system such as that of Sands into a handheld device such as that of Todd. The two patents are directed to two very different telecommunications systems, Sands being concerned with a dynamic call waiting system and Todd being directed to a personal handheld organizer with calendar and telephone functions.

Moreover, the incorporation of a dynamic call waiting system into a handheld wireless device would reduce the effectiveness of the dynamic call waiting system of Sands because of the out of range limitations associated with wireless devices. Sands discloses a stand alone telephone system to which telephones are connected and not an integrated and unified telephone and call waiting system. Neither Sands nor Todd teach or suggest how one would incorporate a dynamic call waiting system into a handheld wireless device.

Further, the intent and purpose of the Sands call waiting system would be thwarted by the use of a handheld wireless device such as Todd in that the Todd device may not be, and in most cases, will not be, permanently connected to a network depending on the location of the handheld device. Consequently, callers

to the handheld device will not be able to schedule a call-back should the handheld device not be in contact with a telephone network.

In summary regarding the combination of references, it is respectfully submitted that, for the reasons set forth above, it would not have been obvious to one of ordinary skill in the art to combine a dynamic call waiting system of Sands with the handheld device of Todd.

Further, as discussed above with regard to independent claims 1, 10 and 15, from which claims 4, 14, 19 and 22-23 depend, Sands fails to teach or suggest the subject matter of the aforementioned independent claims. Moreover, Todd fails to make up the deficiencies of Sands with regard to these independent claims and therefore, even if one of ordinary skill in the art were to attempt to combine the dissimilar teachings of Sands and Todd, the resultant combination would not be that claimed.

Based on the foregoing, it is respectfully submitted that claims 4, 14, 19 and 22-23 are not obvious by Sands in view of Todd and, therefore, it is respectfully requested that the rejection of the aforementioned claims be withdrawn.

Allowance of the application in its present form is respectfully solicited.

END REMARKS